

REMARKS

This Response is submitted in reply to the Office Action dated February 8, 2008. Claims 1 to 25 are currently pending. Claims 1, 10, and 21 are in independent form. No claims are being amended in this response. A Petition for a One Month Extension of Time to respond to the Office Action is submitted herewith. A Supplemental Information Disclosure Statement is also submitted herewith.

The Office Action provisionally rejected claims 1 to 25 on the ground of nonstatutory double patenting over claims 1 to 21 and 23 to 44 of copending U.S. Patent Application No. 10/229,772. A terminal disclaimer is hereby submitted to overcome this rejection.

Please charge Deposit Account No. 02-1818 for any fees due in connection with this Response, the Supplemental Information Disclosure Statement, or the Terminal Disclaimer.

Applicants respectfully submit that the Examiner may not have sufficiently indicated which references were considered from the Supplemental Information Disclosure Statement submitted on December 14, 2007. According to MPEP § 609.01, after the Examiner reviews the IDS for compliance with 37 CFR 1.97 and 1.98, the Examiner should:...(A)(2) Initial the blank column next to the citation to indicate that the information has been considered by the Examiner...(B) Draw a line through the citation to show that it has not been considered if the citation fails to comply with all the requirements of 37 CFR 1.97 and 37 CFR 1.98...(D) Sign and date the bottom of the IDS listing. Applicants submit that the statement that "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /BN/" does not comply with the requirements outlined in MPEP § 609.01. Applicants hereby respectfully request that the Examiner initial the blank column next to the citation of each considered reference from the December 14, 2007 Supplemental Information Disclosure Statement.

The Office Action rejected independent Claims 1, 10, and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Rowe* (2002/0002075) in view of U.S. Patent No. 5,902,983 to *Crevelt et al. (Crevelt)*. Applicants disagree and traverse this rejection.

This application was previously on appeal. Applicants' Pre-Appeal Brief Request for Review filed August 28, 2007 clearly explained why Claims 1, 10, and 21 as presently presented were patentable over *Crevelt*. The Office's Notice of Panel Decision from Pre-Appeal Brief Review dated November 7, 2007, clearly indicated that that the rejection of Claims 1, 10, and 21 should be withdrawn.

More specifically, in the June 29, 2007 Office Action, the Examiner presented certain arguments with respect to Claims 1, 10, and 21. In Applicants' Pre-Appeal Brief Request for Review, each of these arguments was addressed. In the Office's Notice of Panel Decision from Pre-Appeal Brief Review, the Office agreed with Applicants' response to these arguments and reopened prosecution. In the current Office Action, the Examiner appears to be presenting arguments that are substantially identical to the arguments presented in the June 29, 2007 Office Action. In fact, the current Office Action both acknowledges that the Pre-Appeal Brief Request arguments were "found persuasive" (Office Action, page 2) and appears to deem the same arguments "not persuasive" (Office Action, page 9). This position is wholly improper and must be withdrawn.

The only change in the Examiner's argument is the addition of the following:

regarding the method step of "transmitting electronically a fund request from a processor of an electronic fund transfer kiosk to a remote fund repository via an electronic fund transfer network without communicating through a ticket validation network," it would have been obvious for a player to request fund[s] directly from his or her bank, e.g., communicating from the gaming machine to a remote fund repository via a wide area network outside of the casino, without first contacting or getting approval from the casino thus provid[ing] the player more freedom and control over his/her account and speed up the game preparation process. (Office Action, page 5)

Applicants respectfully traverse this rejection. First, the Examiner offers no evidence of this assertion. "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Inter. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1732, 82 USPQ2d 1385, 1389 (2007). The teaching or suggestion to make the claimed combination and

the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments relying on *ex post* reasoning." *KSR* 127 S. Ct. at 1737. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The Examiner's reasoning is thus not sufficient to reject these claims.


In addition, the Examiner's statement does not address the claim language. The claim recites "transmitting electronically a fund request from a processor of an electronic fund transfer kiosk to a remote fund repository via an electronic fund transfer network without communicating through a ticket validation network." Even if it would have been obvious for "a player to request fund[s] directly from his or her bank, e.g., communicating from the gaming machine to a remote fund repository via a wide area network outside of the casino, without first contacting or getting approval from the casino," such a fact does not teach or suggest "sending the request from the gaming device over an electronic fund transfer network to a remote fund repository without communicating through a ticket validation network" as claimed. This rejection must be withdrawn.

Applicants therefore respectfully submit that each of the pending independent Claims, as well as each of the Claims that depend from those independent Claims, is patentably distinguished from *Crevelt* and in condition for allowance.

APPLICANTS RESPECTFULLY REQUEST THAT THE EXAMINER EXAMINE THIS APPLICATION IN ACCORDANCE WITH THE EXAMINATION RULES. IF THIS APPLICATION IS NOT EXAMINED IN ACCORDANCE WITH THE EXAMINATION RULES, APPLICANTS WILL BE FORCED TO FILE ANOTHER APPEAL AND TO BRING THIS APPLICATION TO THE ATTENTION OF THE COMMISSIONER'S OFFICE.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,
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Dated: June 2, 2008